

REMARKS

Summary

Claims 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52, and 61-71 are pending. Claims 1, 7-8, 43, and 65 are amended, and claims 70-71 are added. No new matter is added.

Support for determining whether use of the billing data is valid, for example recited in claim 1, may be found in the Specification at page 12, line 20 to page 13, line 10, as well as elsewhere throughout the Specification.

Rejections Under 35 USC 101

Claims 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52, and 61-69 are rejected under 35 USC 101 as being directed to non-statutory subject matter. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claim 1 is directed to a computer implemented billing service/method that falls in the class of statutory subject matter. While Applicants submit that the claims were previously directed to statutory subject matter, the amendments to claim 1 further clarify this fact. The remaining claims are also directed to statutory subject matter as further discussed below.

Citing the Interim Guidelines for Examination (MPEP 2106), the Office Action states that claim 1 is not directed to a practical application because it does not physically transform an article or physical object to a different state or thing. However, the Office Action summarizes the content of the guidelines in a way that confuses their purpose and obscures the principles of the analysis as further detailed below.

The Interim Guidelines for Examination state that the “claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result’” (citing *State Street Bank*). The guidelines go on to state that the “purpose of this requirement is to limit patent protection to inventions that possess a certain level of ‘real world’ value, as opposed

to subject matter that represents nothing more than an idea or concept”. There is no question that the subject matter of claim 1 provides a useful result and provides a real world value. Claim 1 provides for the obtainment of billing data by a billing service and its provision to a user and notification of usage of the billing data being provided to the billing service to enable the billing service to verify validity of the usage. That information is quite useful to the billing service, the user, and/or the billing data issuing source(s), and the obtainment of that information in its practical form is enabled by the operations recited in claim 1.

The Interim Guidelines for Examination provide a stepwise process that the Examiners are encouraged to follow to determine whether such a claimed invention is directed to patentable subject matter. The guidelines provide that an Examiner should first determine whether the claim(s) fall into one of the statutory categories (process/method, machine, manufacture, or composition of matter). Claim 1 is clearly directed to a method, which is an express category of patentable subject matter. Exceptions to these categories are abstract ideas, laws of nature, and natural phenomena. These exceptions do not apply to the pending claims, and thus the analysis should stop here.

Even assuming the claims could be considered to be directed to an abstract idea, law of nature, or natural phenomena (an interpretation with which Applicants disagree), the analysis must continue further as methods and products employing abstract ideas, laws of nature, or natural phenomena to perform a real-world function or practical application may be patentable. A practical application may be shown when the claimed invention either (A) transforms an article or physical object to a different state or thing, or (B) otherwise produces a useful, concrete, and tangible result. As discussed above, the claims clearly provide a useful, concrete, and tangible result.

In this regard, the Office Action goes on to cite *In re Comiskey* for holding that “a process reciting subject matter without being implemented on an apparatus has been held to be non-statutory process” (from page 4 of the Office Action). This statement is not supported in its broad presentation by the decision in *In re Comiskey*. *In re Comiskey* provides that algorithms and abstract ideas are statutory

subject matter only if, as employed in the process, the algorithms/ideas are embodied in another class of statutory subject matter, such as a machine. This discussion thus applies to claims that are directed to algorithms and abstract ideas, as the subject matter of the claims in the application at issue in *In re Comiskey* was determined to be directed to purely mental steps. The case is thus not on point as the pending claims are not directed to purely mental steps, abstract ideas, or algorithms.

Furthermore, despite the above-identified analysis, the court in *In re Comiskey* found that the claims directed to mental steps embodied in a computer system were patentable subject matter. Thus, even if it is determined that pending claim 1 is directed to a mental step or abstract idea (an interpretation with which Applicant disagrees), claim 1 is clearly computer implemented and according to *In re Comiskey* would be sufficiently presented to satisfy 35 USC 101.

For the variety of reasons presented above, Applicants submit that the pending claims are directed to statutory subject matter. Applicants thus request reconsideration and withdrawal of the rejection.

Rejections Under 35 USC 112, Second Paragraph

Claims 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52, and 61-69 are rejected under 35 USC 112, second paragraph. Although Applicants submit that the claims were definite as previously presented, in order to expedite prosecution of the present application, Applicants herein amend claims 1, 7-8, 43, and 65 to better present the features of the claimed invention. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection.

With respect to the first clause of claim 1 in which it is stated “operating with one or more computing devices a billing service independent of one or more billing data issuing sources,” the Office Action indicates that this provision is interpreted to identify the relationship between the billing service and the billing data issuing source(s). That is an accurate interpretation as clearly presented in claim 1. Thus, the features appear clear and definite as presented.

With respect to the communication links between the billing service, the billing data issuing source(s), and the user(s), the claims provide a sufficient recitation of the relationship between the parties to satisfy 35 USC 112, second paragraph. The various mechanisms available for communication between parties are well understood in the art, and are further described and detailed in the Specification. The lack of specific protocols or identified lines of communication in the claims do not render the claims indefinite as the scope of the claims is clear. For example, with respect to claim 1, an identification of the particular manner in which the parties communicate or exchange information is not necessary for the claimed invention, as the fact that billing data is obtained, provided, and used, and notification of the use is further provided sufficiently establishes the relevant relationship elements among the parties, whether the billing data, notification(s), etc. are provided over a network, through HTTP, FTP, or otherwise.

The remaining issues have been addressed by the clarifying amendments to the claims.

Thus, Applicants submit that claims 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52, and 61-69 are definite, and respectfully request reconsideration and withdrawal of the rejection.

Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1-4, 7-10, 13-15, 18-20, 22-25, 43-45, 48, 50-52, and 61-71 are in condition for allowance. Early issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
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